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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,245	12/13/2001	Bin Takigawa	S002-4503	1504

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05/07/2003

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EXAMINER .

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,245

Applicant(s)

TAKIGAWA, BIN

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. *The information disclosure statement filed 12/13/01 has been considered and placed in the application file.*

Claim Rejections - 35 USC § 112

2. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. *Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for rosin as the "resin" component, palmitic acid alkyl ester as the "fatty acid alkyl ester" component and terpenic oil, heptane, 2-butanone and 1,4-dioxane as the "solvent(s)", does not reasonably provide enablement for the "resin", "fatty acid alkyl ester" and "solvent" falling within the broad scope of the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The invention, as originally described in the specification, is drawn to a coating solution of improved properties. Because it is believed that the nature of the ingredients used in formulating the coating solution would affect such, it is doubted that all would be operable or that given the present specification, one could determine, without undue experimentation, which are or are not operable falling within the broad scope of the claimed invention.*

Claim Rejections - 35 USC § 112

4. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. *Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "comprising amides" per claims 1 and 6 constitutes indefinite subject matter as per it not being readily ascertainable as to how many "amides" are intended based on the use of the plural form of "amide".*

B) *The recited "comprises a compound of the amides" per claim 27 constitutes indefinite subject matter as per said terminology engenders awkwardly expressed claim language. Use of "comprises an amide compound" is suggested.*

C) *The recited "wherein the functional agent comprises the resin made of a rosin" per claims 3 & 8 and "wherein the functional agent comprises the fatty acid alkyl ester composed of" per claims 4 and 9 constitutes indefinite subject matter as per "comprises/consisting of" is broader terminology dependent from narrower terminology and improper. Further, the claim language is awkwardly expressed. The following language is suggested: "wherein the functional agent is a rosin"(claims 3 and 8) and "wherein the functional agent is a palmitic acid alkyl ester"(claims 4 & 9).*

D) *The recited "terpenic oil" per claims 5 and 10 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact meaning intended since the suffix "ic" translates to having the characteristic of".*

Specification

6. *The disclosure is objected to because of the following informalities: On page 4 @ line 6, "feture" should read "feature" and on page 6 @ about line 12, "are shown in the above." engenders an incomplete sentence.*

Appropriate correction is required.

Allowable Subject Matter

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7. *The following is a statement of reasons for the indication of allowable subject matter: The instantly claimed invention is deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the meticulously defined amide-containing coating solution. The closest prior art to Hollub et al (U.S. Patent 3,150,048) teaches nail lacquer removing preparations comprising an organic solvent, an internally plasticized polymer such as a plasticized acrylic polymer, a lipophilic ingredient such as isopropyl palmitate, a gloss enhancer such as a silicone oil and other customary additives such as dyes and perfumes. One having ordinary skill in the art would not have been endowed with any motivation to add an amide compound, falling within the scope of the claims, to the nail lacquer removing composition of Hollub et al with any reasonable expectation of success. Claims 1-10 would be allowed if rewritten, amended and/or satisfactorily rebutted so as to overcome the 112 issues raised supra.*

Conclusion

8. *The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Judy M. Reddick
Primary Examiner
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JMR *JMR*
May 2, 2003